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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/568,777	12/07/1995	RONALD L. SMITH	TI-22187	7439
23494	7590	09/29/2005	EXAMINER	
TEXAS INSTRUMENTS INCORPORATED P O BOX 655474, M/S 3999 DALLAS, TX 75265			MYERS, PAUL R	
			ART UNIT	PAPER NUMBER
			2112	
DATE MAILED: 09/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/568,777

Applicant(s)

SMITH ET AL.

Examiner

Paul R. Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 and 30-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20, 21 and 24-27 is/are allowed.
- 6) ☒ Claim(s) 15-19, 22-23, 28, 30-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 15-19, 30-42 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

In regards to applicants argument that since Sainton teaches a cable connecting the radiotelephone to the computer, Sainton does not teach the added claim limitation of the computer being directly connectable without a cable or tethered connection to the telephone. The examiner agrees. However Morris expressly shows a computer directly connectable without a cable or a tethered connection to a telephone.

In regards to applicants argument that Morris expressly teaches that the battery pack has been removed. The examiner agrees. However the rejection is Sainton in view of Morris. Sainton expressly teaches both the computer and the telephone have a battery. The examiner sees no reason a battery could not be included in the telephone of Morris. It would have been obvious to maintain a battery in the telephone of Morris because this would have allowed for using the telephone separately from the computer without having the also carry a battery pack for the telephone. Since Hop does not expressly teach the telephone having a battery, the rejection to Hop will be dropped. The examiner notes this would simply require a movement of the physical position of the track or battery. "Not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly

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evaluated in formulating a rejection." *In re Preda*, 401 F.2d 825, 159 USPQ 342 (CCPA 1968) and *In re Shepard* 319 F.2d 194, 138 USPQ 148 (CCPA 1963).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969.

The test of obviousness is:

"whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention," *In re Gorman*, 933 F.2d at 986, 18 USPQ 2d at 1888.

Subject matter is unpatentable under section 103 if it "'would have been obvious . . . to a person having ordinary skill in the art.' While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination." *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ 2d 1500, 1502 (Fed. Cir. 1988).

"Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same [or] similar problem which it addresses." *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979).

"In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found *in* a specific reference."

Entire quote from *In re Oetiker*, 24 USPQ 2d 1443 (CAFC 1992).

Accordingly, it is not required to disclose or specifically suggest particular elements. Instead the measure is what the teachings would suggest to one of ordinary skill in the art, not what the art specifically suggests.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 15, 17, 19, 22-23, 28, 30-44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sinton PN 5,249,218 in view of Morris PN 5,020,090.

In regards to claims 15, 30, 38: Sinton teaches a computer (104) comprising: a provision for user input (keyboard); a provision for output (display); a microprocessor (106) coupled to said user input and said output; and an interface (110); coupled to said microprocessor (106), said interface being directly connectable to a corresponding interface (118) in a portable telephone (116), wherein said interface comprises at least one voice channel lead (RX/SPK), one command channel lead (DIO/DATA), and a ground/reference lead (GND) for connection to corresponding leads in a corresponding interface in said portable telephone. Sinton teaches a cable connection Sinton does not teach a connecting the computer to the telephone without a cable or tethered connection. Morris teaches a computer directly connected to a telephone

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without a cable or a tethered connection (Figure 2). It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide a connection without a cable because this would have prevented having to also carry a cable for interconnection.

In regards to claim 17: Sainton teaches the command channel being a bidirectional half-duplex signal line (Column 13 lines 10-14).

In regards to claims 19 and 28: Sainton teaches the voice channel used for Data/Audio (Column 12 line 50 to Column 13 line 16). Sainton also indicates the audio is digitized voice (Column 11 lines 14-33).

In regards to claim 22: Sainton teaches said interface further including a second voice channel lead (TX/TXAF) (Column 3 lines 64-65 Table 2 and Column 13 lines 10-16).

In regards to claim 23: Sainton teaches the voice channel leads facilitating a unidirectional full duplex mode (While Sainton does not use the words unidirectional full duplex Sainton teaches two separate wires one input and one output RX and TX. Which are for receiving and transmitting data respectively Column 5 lines 59-60 and Column 10 lines 50-60 thus unidirectional and transmits and receives data thus full-duplex Column 17 lines 32-35)

In regards to claim 31: Sainton teaches a keyboard (Column 4 line 55 to Column 5 line 9).

In regards to claim 32: Sainton teaches a display (Column 4 lines 55 to Column 5 line 9). The examiner further notes the telephone is a cellular telephone which would also include a keyboard and display.

In regards to claim 33, 36, 39, 42: Sainton teaches one apparatus being a computer (104).

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In regards to claim 34, 35, 37, 40, 41: Sainton teaches one apparatus being a radio telephone (116).

In regards to claim 43: Sainton teaches the computer system attached to a cellular telephone as described above. Sainton does not expressly teach said interface is located within a cavity in said computer. Morris teaches a laptop computer including an interface (94) located within a cavity (mounting Track Figure 2) for holding a cellular telephone. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include a cavity for holding the cellular telephone because this would have allowed for separability between the computer and the cell phone (See Morris Column 1 lines 30-36). Further, Sainton and Morris are in the same field of endeavor in that both references seek to provide mobile communications capability in a portable computer environment. Sainton also expressly teaches that both the computer and the radiotelephone have a battery.

In regards to claim 44: Morris teaches the portable telephone fits at least partially within said cavity.

In regards to claim 46: Morris teaches a mechanism on said computer (30) that cooperates with a corresponding mechanism (46) for removably securing said portable telephone to said computer (see figure 6).

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton PN 5,249,218 in view of Morris PN 5,020,090 as applied to claim 15 above, and further in view of Kyu et al PN 4,225,919.

In regards to claim 16: Sainton teaches the voice channel being unidirectional full-duplex (With TX/TXAF being the second channel See figure 3) instead of bidirectional half-duplex. Kyu et al teaches two basic types of data links are well known, including both bidirectional half-duplex and unidirectional full-duplex (See figures 2A and 2B and Column 7 lines 39-42). It would have been obvious to a person of ordinary skill in the art at the time of the invention to use bidirectional half-duplex because this would have decreased the number of required signal lines (As shown in Figure 2A with only 1 signal line and Figure 2B with 2 signal lines).

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton PN 5,249,218 in view of Morris PN 5,020,090 as applied to claim 15 above, and further in view of Dent et al PN 5,581,597.

In regards to claim 18: Sainton teaches the interface described above. Sainton does not teach the interface including a power line. Dent et al teaches (Column 8 lines 52-57) a cellular terminal (such as a cellular telephone) that is powered by an external signal line while the cellular terminal is "parked". It would have been obvious to include a power signal line because this would have allowed for recharging the cell phone (Figure 3 battery charger 153).

6. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton PN 5,249,218 in view of Morris PN 5,020,090 as applied to claim 43 above and further in view of Kobayashi PN 5,111,361.

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In regards to claim 45: Sainton in view of Morris teaches the computer with a cellular telephone housed within a cavity of the computer as described above. Morris does not expressly teach that the cellular telephone can fit completely within the cavity of the computer. Kobayashi teaches a notebook computer in which the battery pack (21) fits completely within a cavity for holding the battery pack (Flush with the surface). It would have been obvious to fit Morris's cellular telephone completely within the computer flush with the surface because this would have been aesthetically pleasing.

7. Claims 20-21 and 24-27 are allowed.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 571 272 3639. The examiner can normally be reached on Mon-Thur 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rehana Perveen can be reached on 571-272-3676. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRM
September 27, 2005


PAUL R. MYERS
PRIMARY EXAMINER